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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gibson Guitar Corp.

Serial No. 76230196

Lucian Wayne Beavers and Edward D. Lanquist, Jr. of Waddey
& Patterson, P.C. for Gibson Guitar Corp.

Matthew J. Pappas, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Hohein and Bucher, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Gibson Guitar Corp. seeks registration on the
Principal Register of the mark LP for goods identified in
the application as "stringed musical instruments - namely,
electric guitars," in International Class 15.¹

This case is now before the Board on appeal from the
final refusal of the Trademark Examining Attorney to
register applicant's mark based upon Section 2(d) of the

¹ Application Serial No. 76230196 was filed by Gibson Guitar Corp. on March 26, 2001 based upon applicant's allegation of a *bona fide* intention to use this mark in commerce.

Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney has taken the position that applicant's mark, when used in connection with electric guitars, so resembles the six marks shown below in registrations owned by the same party,² as to be likely to cause confusion, to cause mistake or to deceive:



for "percussion musical instruments," in International Class 15;

Reg. No. 0880477 issued on November 11, 1969, section 8 affidavit accepted and section 15 affidavit acknowledged; second renewal in 1999; the word "Percussion" is disclaimed apart from the mark as shown;



for "percussion musical instruments, bags for musical instrument equipment," in International Class 15;

Reg. No. 1292158 issued on August 28, 1984, section 8 affidavit accepted and section 15 affidavit acknowledged; renewal in 2003;



for "hand percussion instruments," in International Class 15;

Reg. No. 2329912 issued on March 14, 2000; the words "Music Collection" are disclaimed apart from the mark as shown;

² The prosecution history of this case reveals that this case was suspended for a period of time while applicant sought to negotiate a consent agreement with registrant, although ultimately it was not successful in this effort.

LP ASPIRE

for "percussion instruments, namely, congas, bongos, timbales, drums, cowbells, blocks, tambourines, chimes, bells, triangles, shekeres, guiros, shakers, maracas, claves, castanets, whistles, cymbals, gongs, sticks, beaters; mounts, brackets, stands, percussion tables for use therewith; bags and carrying cases for carrying and storing musical instruments," in International Class 15;

Reg. No. 2386372 issued on Sept 12, 2000;



for "percussion instruments, namely, congas, bongos, timbales, drums, cowbells, blocks, tambourines, chimes, bells, triangles, shekeres, guiros, shakers, maracas, claves, castanets, whistles, cymbals, gongs, sticks, and beaters, mounts, brackets, stands, and fitted bags and fitted cases all for use with percussion instruments, and percussion tables," in International Class 15;

Reg. No. 2391247 issued on October 3, 2000; and



for "musical instruments, namely, percussion instruments," in International Class 15.

Reg. No. 2557301 issued on April 2, 2002.

Applicant and the Trademark Examining Attorney submitted briefs. Applicant did not request an oral hearing.

Applicant argues that when its LP mark is used in connection with guitars, it does not create a likelihood of confusion with registrant's use of its LP derivative marks in connection with percussion instruments for a variety of reasons:

- The goods are not sufficiently similar to support finding a likelihood of confusion.
- LP on guitars means LES PAUL to guitar purchasers, while LP on drums means LATIN PERCUSSION to purchasers of percussion instruments such as drums.
- Because of these different associations, the marks are sufficiently different to allow applicant's mark LP to register in connection with electric guitars while registrant's LP formative marks are registered in connection with percussion instruments.
- There have been thirty-four years of contemporaneous use without actual confusion.
- There is no likelihood of confusion with the registered marks because registrant's products are always otherwise branded as LATIN PERCUSSION while applicant's products are branded as LES PAUL.

By contrast, the Trademark Examining Attorney takes the position that the dominant portions of the marks are identical; that "the dominant letters LP ... have come to be recognized by consumers as indicative of registrant's family of marks in the music industry"; that as used, applicant's typed drawing could be presented in any style of lettering, including ones most similar to registrant's designs; that the goods themselves and the channels of trade are closely related; and that a bold assertion by applicant's president that based on his personal knowledge, "no consumer has been confused" despite thirty four years of concurrent use, is not definitive in this limited, *ex parte* context.

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing upon the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Accordingly, we turn first to the du Pont factor focusing on the relatedness of applicant's goods to the goods in the cited registrations.

The Trademark Examining Attorney argues that applicant's guitars are closely related to registrant's percussion instruments. The record contains third-party registrations and webpages demonstrating that both of these types of musical instruments are manufactured and marketed by entities utilizing a single trademark to indicate the source of both types of goods.³ Hence, the Trademark Examining Attorney concludes " ... it is highly likely that purchasers of musical instruments, upon seeing highly similar marks used on and in connection with closely-related goods, would believe that the goods emanate from the same source." Trademark Examining Attorney's appeal brief, pp. 6 - 7.

By contrast, applicant argues that its goods "are not sufficiently similar" (applicant's brief, p. 12) to registrant's goods to support a likelihood of confusion in this case:

³ Copies of the webpages were attached to the Office action of May 20, 2002 and the third-party registrations were attached to the Office actions of May 20, 2002 and October 7, 2004 (denying applicant's request for reconsideration of the final refusal).

The examiner said that others sell drums and guitars making the goods sufficiently similar to create a likelihood of confusion. The examining attorney uses the "emanation rule." However, the "emanation rule" creates a *per se* rule that any goods and services that could emanate from the same source are related for the purposes of §2(d). Such a finding creating a *per se* rule is improper. See, e.g., Information Resources Inc. v. X*Press Information Services, 6 USPQ2d 1034, 1038 (TTAB 1988) [regarding computer hardware and computer software]; Hi-Country Foods Corp. v. Hi Country Beef Jerky, 4 USPQ2d 1169, 1171 (TTAB 1987) [regarding food]; In re British Bulldog, Ltd., 224 USPQ 854, 855-56 (TTAB 1984) [regarding clothes]. Therefore, to find the goods similar because others make both goods is improper. To be honest, emanation may be a proper approach is [sic] many instances. However, where the marks have been used in connection with the goods for such a long period of time confusion-free, the analysis is improper. Therefore, the combination of the extended concurrent use without confusion combined with the differences in marks and goods justifies a reversal of the refusal to register.

There are a number of reasons why we disagree with applicant on this point.

First, the Trademark Examining Attorney has properly placed into the record third-party registrations that are based on use in commerce. Although they are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, they do have probative value to the extent that they may serve to

suggest that such goods are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). Applicant argues that this "emanation rule" creates an "impermissible *per se* rule." We disagree. An example of an impermissible *per se* rule in this case would be if the Trademark Examining Attorney, in his attempt to justify the relatedness of these respective goods, had merely concluded 'that electric guitars and percussion instruments are related because both are classified in International Class 15.' By contrast, under *Albert Trostel*, *supra*, these third-party registrations have probative value for the very purpose the Trademark Examining Attorney placed them into the record - namely, they suggest that these respective goods are of a type that may emanate from a single source.

Second, in addition to the third-party registrations, the Trademark Examining Attorney has made of record pages taken from various websites. These materials show marks that are in use on a commercial scale for guitars and drums.⁴

⁴ Gretsch Musical Instruments: *Home of that Great Gretsch Sound!* <http://www.gretsch.com/intro.html>

Yamaha Musical Products: [two of five product groups: "Guitars and Electric Basses" and "Drum Sets and Percussions"] <http://www.yamaha.com>

As a final observation on the relatedness of electric guitars and percussion instruments, in addition to the probative evidence drawn from the third-party registrations and several webpages, it is common knowledge that any rock band needs, at a minimum, a guitar and a set of drums.

Furthermore, as to the du Pont factor focusing on the similarity of established, likely-to-continue trade channels, the record demonstrates that guitars and percussion instruments are sold through the same channels of trade, and that both products would be sold to the same class of ordinary consumers.

We turn next to the du Pont factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound and connotation. All six of the marks in the cited registrations contain the letters "LP" as their dominant elements.⁵ Moreover, we

Although being sold under a separate product mark, applicant's own website has a link under the heading "Drums" to the "Slingerland Drums."

<http://www.gibson.com/products/instindex/index.html>

⁵ Although the Trademark Examining Attorney argues that consumers have come to recognize the letters "LP" as "indicative of registrant's family of marks in the music industry," simply using a series of similar marks does not of itself establish the existence of a family, and the Trademark Examining Attorney has not met the burden of demonstrating a family of marks. J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991). Thus, in reaching our conclusion on likelihood of confusion, we have not treated the registered marks as being part of a family.

agree with the Trademark Examining Attorney that Reg. Nos. 1292158 and 2391247 are the most similar to applicant's mark, consisting of just the letters LP on a background circular "carrier" device. Because they are the most similar, we have chosen to focus primarily on these two marks in assessing the likelihood of confusion herein. A circle background is one of the most common and ordinary background designs used in trademarks, and as such, has no real trademark significance. Accordingly, applicant's mark is not only identical to these registered marks in sound and connotation, but it is extremely similar in appearance.⁶ Hence, when compared in their entireties, we find that applicant's mark creates a similar overall commercial impression to the marks in the cited registrations.⁷

⁶ We should also note that as a consequence of applicant's mark having been depicted as a standard character drawing, it may be displayed in any reasonable format, including having it appear within a circle background as shown in several of the cited registrations. See INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992), citing Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971).

"[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a difference cannot legally be asserted by that party....

Thus, ... the displays must be considered the same."

Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). (*italics* in original).

⁷ In limiting our discussion to Registration Nos. 1292158 and 2391247, we do not mean to imply that there is no likelihood of

Moreover, as to connotation, we disagree with applicant's argument that the mark LP has different connotations when applied to these different goods. Apart from any arguable associations with, or abbreviations for, "Les Paul" or "Latin Percussion," LP appears to be totally arbitrary as applied to musical instruments. Accordingly, this is clearly not a case where the term intrinsically has a different connotation as applied to the respective goods.⁸

On a related du Pont factor - the number and nature of similar marks in use on similar goods - we also point out that, based upon the record before us, we must consider LP to be a strong mark. This is because there is no evidence of third-party use or registration of LP marks for similar goods.

A critical part of applicant's argument that confusion is not likely herein is that in the real world, there are different associations connected with each of these respective marks. Specifically, applicant argues

confusion between applicant's mark and the remaining cited registrations. On the contrary, we find that these marks are also confusingly similar.

⁸ *Contra In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984): "'PLAYERS' for shoes implies a fit, style, color, and durability adapted to outdoor activities. 'PLAYERS' for men's underwear implies something else, primarily indoors in nature."

strenuously that LP means LES PAUL for guitar purchasers, while LP means LATIN PERCUSSION for purchasers of percussion instruments.

In this context, it behooves us to determine from the record whether, as used in connection with guitars, the letters "LP" would be viewed as being interchangeable with LES PAUL.

In the reference work Gibson Les Paul Book, we note the following entries:

"**Gibson catalog 1981** (left) On display are the LP XRI and XRII, which were rather unexciting models devised by one of Gibson's regional sales teams..." ; and

LP XRI/XRII/XRIII

LPXRI 1981-1982 *'XR-I' on truss-rod cover ...*

LPXRII 1981-1982 *'XR-II' on truss-rod cover ...*

LPXRIII 1982 *'XR-III' on truss-rod cover ...*

From the publication Gibson Guitars: Les Paul Models (1970), we see the following types of usage of LES PAUL and LP:

LES PAUL CUSTOM—High Impedence [sic]

... The LP-Custom is popular with rock groups ...

LES PAUL PERSONAL—Low Impedence [sic]

[no use of "LP Personal" in write up]

LES PAUL PROFESSIONAL—Low Impedence [sic]

The Les Paul Professional has many of the same exciting features found on the LP Personal: ...

LES PAUL BASS—Low Impedence [sic]

The frequency response, range of harmonics and crisp, clear tones of the LP Bass will exceed that of any electric guitar on the market to date.

LP-12 AMPLIFIER

Gibson's new Les Paul Amplifier is specially designed ... Those who have heard the LP-12 call it the "Monster" ... and with good reason...

From a number of copies of actual invoices, we note the following types of usage of LP:

6/21/2000	L&M Music (CHATTANOOGA, TN)
<u>Product No.</u>	<u>Model Description</u>
ENS-HSCH1	LP STD HCSB CH HDWE ... ⁹
1/9/2001	Griggs Music, Inc. (DAVENPORT, IA)
<u>Product No.</u>	<u>Model Description</u>
ENC-HSGH1	LP Cust Flametop HCSB GOLD HDW ... ¹⁰

The following table of the annual production of LP guitars over a period of more than a dozen years, taken from Gibson Electronics: The Classic Years, shows the LP letters (like the SG term) as a model designation:

⁹ Elsewhere in the record, it is clear this is a technical, abbreviated designation for "Les Paul Standard Heritage Cherry Sunburst with Chrome Hardware."

¹⁰ Elsewhere in the record, it is clear this is a technical, abbreviated designation for "Les Paul Custom Flametop Heritage Cherry Sunburst with Gold Hardware."

Model	1954	1955	1956	1957	1958	1959	1960	1961	1962	1963	1964	1965
LP CUSTOM	94	355	489	283	256	246	189	*	-	-	-	-
SG/LP CUSTOM	-	-	-	-		-	-	513*	298	264	130	236

In various documents that applicant placed into the record, short blurbs about each of the different guitars within a collection invariably use a guitar designation (e.g., **LES PAUL CUSTOM**) in bold, upper case letters. Below, following the descriptive paragraphs, the literature enumerates, in much smaller print, the various colors and other listed features available on the particular model (e.g., LP Custom Ebony Finish, LP Custom White Finish, LP Custom Heritage Cherry Sunburst Finish, etc.); or show LP as a model designation:

LES PAUL CUSTOM: Model LP Custom ...
 LES PAUL CUSTOM LITE: Model LP Custom Lite ...
 LES PAUL STANDARD: Model LP Standard ...
 LES PAUL STUDIO: Model LP Studio ...
 LES PAUL REISSUE GOLD TOP: Model LP Reissue Gold Top ...
 LES PAUL REISSUE: Model LP Reissue ...
 LES PAUL JUNIOR DOUBLE CUTAWAY: Model LP Jr. DC ...

While the record does indicate that the letters "LP" made an appearance on the headstock of the "Artist" series guitars (1979 - 1981),¹¹ we disagree with applicant's contention that this minimal usage of the LP designation as a trademark on the guitar peg heads of one guitar series

¹¹ Gibson Guitars: 100 years of an American icon: Artist (1979 - 1981), Active electronics, "LP" on the peghead.

for less than two years¹² "has helped to associate the LP acronym with Gibson Guitar's famous LES PAUL guitars." (applicant's response of December 17, 2001).

Similarly, while the declaration submitted by applicant states that applicant has been using the LP designation "on hangtags since April 2001," no such hangtags appear to have been made of record. Moreover, to the extent that the designation is being used on the hangtags in the manner of a model designation - similar to that on price lists, invoices, printed literature and elsewhere in the documents of record, as seen *supra* - this would not help to associate the LP designation with the LES PAUL trademark.

Therefore, having carefully reviewed all the evidence of record, we cannot conclude that consumers, seeing LP used in connection with guitars in the manner shown in the documents of record, would immediately understand it to mean "Les Paul."

Fame is not a relevant factor in this case. Generally, the du Pont "fame factor" focuses on the fame of the registrant's cited mark(s) - a factor about which we

¹² We also note that this particular image (as specifically referenced in the declaration) is not legible in the photocopied images contained in the evidence of record.

have no evidence herein. On the other hand, to the extent that applicant's LES PAUL mark can be considered "famous," that is not relevant to our determination where the mark that applicant seeks to register is LP, and the facts of the case do not support the conclusion that the designation LP will be perceived by prospective purchasers of electric guitars as being interchangeable with the LES PAUL mark.

Applicant also argues that the du Pont factor focusing on the length of time during and conditions under which there has been contemporaneous usage without evidence of actual confusion is supportive of its position that confusion is not likely. Again, we disagree. This application is based on intent-to-use, not use. To the extent that applicant may have used the LP term as a model designation or as an abbreviation, it does not support the conclusion that there have been thirty-four years of use of applicant's LP designation as a *trademark* contemporaneously with registrant's cited LP marks.

Applicant also argues that registrant's products always include the name LATIN PERCUSSION while applicant's products always include the name LES PAUL. However, in determining likelihood of confusion, we must consider applicant's mark as shown in the drawing of its application

compared with registrant's marks as shown in its registrations. This is because a registration gives the registrant the *prima facie* right to use the marks as shown on its registration. Applicant's corollary argument that there is no confusion under real world "marketing conditions" suffers the very same weakness, in that there is no requirement that applicant-turned-registrant must use its house mark, LES PAUL, with its LP designation or that registrant must use its house mark, LATIN PERCUSSION, with its various product trademarks as registered.

In summary, we find that the marks, and particularly applicant's mark and the marks in Registration Nos. 1292158 and 2391247, are substantially identical as to overall commercial impression, that LP appears to be a strong mark in the field of musical instruments, that the goods are closely related, and will move through the same channels of trade to the same classes of consumers.

Finally, to the extent there is any doubt on the issue of likelihood of confusion, we follow the well-established principle that such doubt must be resolved in favor of the registrant and prior user. *In re Mayco Mfg.*, 192 USPQ 573, 576 (TTAB 1976).

Decision: The refusal to register applicant's mark under Section 2(d) is hereby affirmed.